



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/927,963

08/10/2001

David K. Lee

F- 260

6878

919

7590

11/27/2006

EXAMINER

JABR, FADEY S

PITNEY BOWES INC.

35 WATERVIEW DRIVE

P.O. BOX 3000

MSC 26-22

SHELTON, CT 06484-8000

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/927,963	LEE ET AL.	
	Examiner	Art Unit	
	Fadey S. Jabr	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

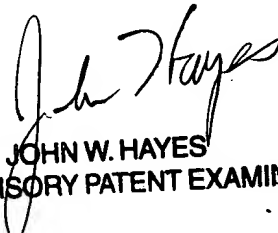
1. In view of the Appeal Brief filed on 6 April 2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Status of Claims

Claims **1-21** are pending in the application and are again presented for examination.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/339768, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The newly added limitations regarding a unique sender generated identifier have not been described in the prior applications in a manner that would allow granting of priority.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims **6, 16 and 21** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claims 6 and 16**, the recitation "...the unique sender generated identifier and *supplying to the address information* about the location of the mail item" is vague and indefinite.

It is unclear to the Office how the location of the mail item can be supplied to an *address*.

Appropriate correction is required in the indicated claims and any subsequent claims.

As per **Claim 21**, the claim recites the limitation "the means for including" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **1-7, 9-11, 16-17 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al., Pub. No. US2002/0032623 A1.

As per **Claims 1**, Wheeler et al. discloses a method comprising:

- inducting the mail item into the carrier distribution system, the mail item having thereon a unique sender generated identifier (0005-0006, 0014);
- assigning a unique carrier generated identifier to the mail item (0012, also see Claims 1 and 25);
- associating the unique sender generated identifier with the unique carrier generated identifier (0012);

Wheeler et al. fails to *explicitly* disclose obtaining the unique sender generated identifier from the mail item during processing of the mail item in the carrier distribution system. However, Wheeler et al. discloses a mechanism for entering a mail item into the system for generating and storing a record of the mail item, where this step can be conducted in any mail application and environment (0014; 0031, lines 10-13).

Further, Wheeler et al fails to *explicitly* disclose the carrier tracking the location of the mail item through the carrier distribution system using the unique carrier generated identifier; and allowing the sender to obtain location information about the mail item using the unique sender generated identifier without the sender having knowledge of the unique carrier generated identifier. However, Wheeler et al. discloses tracking mail items through a mail system (0005). Wheeler et al. also discloses a carrier having its own tags and ID codes, the record (senders mail item ID, codes, and information pertaining to the mail item) for an item is utilized in conjunction with carrier software to generate a carrier tag with a carrier ID, where the system may also utilize the records to generate reports in response to requests for such reports from selected authorized system users (0012-0013). Moreover, Wheeler et al. discloses a fourth mechanism by which the

Art Unit: 3628

system utilizing the record the record for an item obtains a response to a query from an authorized system user relating to the item and provides a response to the user, wherein the mechanism looks at appropriate fields of item records (sender and carrier associated information) to respond to such queries (0014). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Wheeler et al. and include using a sender generated mail item tags and ID codes along with carrier generated mail item tags and ID codes to track mail items through a shipping system, because it allows for more than one field of information of an item record when responding to tracking queries.

As per **Claim 2**, Wheeler et al. discloses applying the unique carrier generated identifier to the mail item (00120).

As per **Claim 3**, Wheeler et al. fails to *explicitly* disclose applying the unique carrier generated identifier in a bar code form. However, Wheeler et al. discloses generating carrier tags and ID codes, where the sender generated tags and ID codes are included on a label as an ID and bar code (0012, 0038). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Wheeler et al. and include a carrier label containing a bar code, because it allows for quick and efficient scanning of mail items.

As per **Claim 4**, Wheeler et al. discloses wherein the unique sender generated identifier is in a bar code form (0038).

Art Unit: 3628

As per **Claim 5**, Wheeler et al. discloses wherein the mail item has a recipient address printed thereon and the unique sender generated identifier is located on the mail item proximate the recipient address and further comprising using the unique sender generated identifier for locating the recipient address (0038, also see Figure 3).

As per **Claim 6**, Wheeler et al. discloses wherein the unique sender generated identifier includes an address and further comprising the carrier obtaining the address from the unique sender generated identifier and supplying to the address information about the location of the mail item (0006, 0038).

As per **Claim 7**, Wheeler et al. discloses wherein the address is one of an e-mail address, a pager number, and a facsimile machine number (0008-0009).

As per **Claim 9**, Wheeler et al. discloses uniquely associating the uniquely associating the unique sender generated and unique carrier generated identifiers by storing them in a file (0006, 0012).

As per **Claim 10 and 19**, Wheeler et al. fails to *explicitly* disclose reading the unique carrier generated identifier at a plurality of locations throughout the carrier distribution system, storing in the file a date stamp, a time stamp, and a location identifier each time the reading of the unique carrier generated identifier occurs, and associating in the file the date stamp, time stamp, and location identifier with the unique carrier generated identifier and the unique sender

Art Unit: 3628

generated identifier. However, Wheeler et al. discloses a carrier tag and ID codes being utilized in conjunction with the sender records (sender mail item tags and ID codes), where the system may utilize the records to generate reports to requests for such reports from selected authorized system users (0012). Further, the mail item status query allows for time interval matches, recipient/sender match, mail item type match, updates the record for an item as the item reaches certain points in transport, and other criteria match (0013-0014, also see figure 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Wheeler et al. and include a variety of criteria matches for mail item status queries, because it allows the system user to make use of a collection of mail item data to retrieve status information concerning the location of the mail item.

As per **Claim 11**, Wheeler et al. discloses a system comprising:

- means for reading the unique sender generated identifier from the mail item (0014, also see Figures 1 and 2);
- means for including a unique carrier generated identifier on the mail item (0014, also see Figures 1 and 2);
- a database that associates the unique sender generated identifier with the unique carrier generated identifier (0080);

Wheeler et al. fails to *explicitly* disclose at least one sensor that reads the unique carrier generated identifier from the mail item and provides location information to the database that is associated with the unique carrier generated identifier so that at times when the carrier distribution system receives a location query from an entity about the mail item via submission

Art Unit: 3628

of the unique sender generated identifier the location information is obtainable from the database without requiring submission of the unique carrier generated identifier by the entity. However, Wheeler et al. discloses a scanner for reading mail item tags and ID codes (0006, 0014, also see Figures 1 and 2). Further, Wheeler et al. discloses a query system where queries into the status of the mail item can be made using a variety of information, including mail item tags, where the records are retrieved from the tag server (0014, 0055). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Wheeler et al. and include using various mail item record data in a query to determine the status of a mail items, because it allows the system user to make use of a collection of mail item data to retrieve status information concerning the location of the mail item.

Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App & Inter. 1987). Thus, the structural limitation of claim 11, including a sensor is disclosed by Wheeler et al. as described above. Also, as described above, the functional limitations in claim 11 do not distinguish the claimed apparatus from the prior art.

As per **Claim 16**, Wheeler et al. discloses wherein the unique sender generated identifier includes an address and the means for reading obtains the address from the unique sender

Art Unit: 3628

generated identifier and supplies to the address an indication that the mail item has been read at the means for reading (0013-0014).

As per **Claim 17**, Wheeler et al. discloses wherein the address is one of an e-mail address, a pager number, and a facsimile machine number (0008-0009).

7. Claims **12-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al. Pub. No. US2002/0032623 A1 in view of Official Notice.

As per **Claim 12**, Wheeler et al. fails to disclose an automatic facer/canceller. However, Wheeler et al. discloses an Optical Character Recognition system used to determine the mail item information (see Figure 1). However, Examiner takes Official Notice that automatic facer/cancellers are old and well known in the art at the time of the Applicant's invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Wheeler et al. and include an automatic facer/canceller, because it is a vital part of any mail processing system, which is used to process mail items entering the sorting system.

As per **Claim 13**, Wheeler et al. fails to *explicitly* disclose applying the unique carrier generated identifier in a bar code form. However, Wheeler et al. discloses generating carrier tags and ID codes, where the sender generated tags and ID codes are included on a label as an ID and bar code (0012, 0038). Therefore, it would have been obvious to one of ordinary skill in the art

Art Unit: 3628

at the time of applicant's invention to modify the method of Wheeler et al. and include a carrier label containing a bar code, because it allows for quick and efficient scanning of mail items.

As per **Claim 14**, Wheeler et al. discloses wherein the unique sender generated identifier is in a bar code form (0038).

As per **Claim 15**, Wheeler et al. discloses wherein the mail item has a recipient address printed thereon and the unique sender generated identifier is located on the mail item proximate the recipient address (0014, also see Figure 3). Wheeler et al. fails to disclose an automatic facer/canceller. However, Wheeler et al. discloses an Optical Character Recognition system used to determine the mail item information (see Figure 1). However, Examiner takes Official Notice that automatic facer/cancellers are old and well known in the art at the time of the Applicant's invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Wheeler et al. and include an automatic facer/canceller, because it is a vital part of any mail processing system, which is used to process mail items entering the sorting system.

8. Claims **8 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al., Pub. No. US2002/0032623 A1 in view of Park et al., Pub. No. US2001/0010334 A1.

As per **Claims 8 and 18**, Wheeler et al. fails to disclose wherein the unique sender

Art Unit: 3628

generated identifier includes an electronic address and additional data that uniquely identifies the mail item. However, Park et al. teaches notifying the state in which the mail item is being processed on the E-mail address of a sender, so that the sender can know the processing procedure of the mail item (0012). Further, Park et al. teaches a user registering his/her zip code and E-mail address, etc. into a postal service server in the postal office and then inputting a zip code and name of the recipient. Then, the postal service server receives them to generate information frame to be printed on 4-state barcode and a code word for error correction and then transmits the formation frame and the code word to a barcode printing system to print a customer's barcode (0020). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Wheeler et al. and include generating information frame to be printed on 4-state barcode using all of the above data as taught by Park et al., because it provides a considerable amount of information regarding the mail item and sender/recipient of the mail item onto the mail item, where the information is used to sort the mail item and notify the mail customer of the status of the mail item.

9. Claims **20-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al., Pub. No. US2002/0032623 A1 in view of Petkovsek, U.S. Patent No. 6,089,613.

As per **Claim 20**, Wheeler et al. fails to disclose wherein the unique sender generated identifier includes an indication of the type of premium service that is requested for the mail item. However, Petkovsek teaches a label identifying the type of special service for the mail item (C. 3, lines 23-33). Therefore, it would have been obvious to one of ordinary skill in the art

Art Unit: 3628

at the time of applicant's invention to modify the system of Wheeler et al. and include identifying the type of mail service on a label as taught by Petkovsek, because it provides information to the carrier of the method to use to process the mail item.

As per **Claim 21**, Wheeler et al. discloses wherein the means for including is a printer (See Figure 2).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

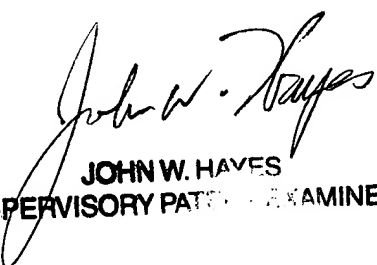
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FSJ


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Fadey S Jabr
Examiner
Art Unit 3628

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-1516 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314